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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,825	05/22/2001	Satoru Ueda	7217/64562	8871

530 7590 07/12/2006

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EXAMINER

YIGDALL, MICHAEL J

ART UNIT

PAPER NUMBER

2192

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/862,825

Applicant(s)

UEDA, SATORU

Examiner

Michael J. Yigdal

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 16, 2006 has been entered. Claims 1, 3, 4 and 10 are pending.

### ***Response to Arguments***

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection, as set forth below with reference to Hellman. Applicant's amendment necessitated the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Pub. No. WO 97/14085 to Reeder (art of record, "Reeder") in view of U.S. Patent No. 5,375,240 to Grundy (art of record, "Grundy") in view of U.S. Patent No. 4,658,093 to

Hellman (art of record, "Hellman") in view of U.S. Patent No. 6,081,785 to Oshima et al. (art of record, "Oshima").

With respect to claim 1 (currently amended), Reeder discloses a software program providing system for providing and managing access to a software program (see, for example, FIG. 1 and page 3, lines 11-15), said system comprising:

(a) a storage medium for storing the software program and for storing an individual identification code that identifies said storage medium (see, for example, store 150 in FIG. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium);

(b) a user terminal for installing said storage medium therein and for accessing the software program stored in said storage medium (see, for example, apparatus 100 in FIG. 1, and page 3, lines 11-15 and line 32 to page 4, line 6, which shows a personal computer or user terminal having a storage medium installed therein for storing and accessing software programs, and see, for example, page 5, lines 10-14, which shows obtaining the software program and storing it in the storage medium);

(c) database management means for storing a database that includes individual information of a user, information regarding a range of access limitations to the software program, and information regarding a condition of access to the software program, the database being searchable using the individual identification code as a search key (see, for example, code data 230 and bill log 240 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code), the

Art Unit: 2192

information regarding the range of access limitations including a plurality of supplemental pay functions (see, for example, page 10, lines 17-27, which shows a plurality of supplemental pay features or functions), the information regarding the condition of access including an associated number of used counts for a given one of the plurality of supplemental pay functions, the associated number of use counts indicating the number of prior accesses to the given one of the plurality of supplemental pay functions (see, for example, page 11, line 31 to page 12, line 14, which shows an associated record or count of each use of the feature or function).

Reeder discloses an associated message number (see, for example, page 11, lines 8-19) that is incremented when a feature or function is purchased (see, for example, column 10, lines 31-34), but does not expressly disclose the information regarding the condition of access including an associated number of purchased counts for a given one of the plurality of supplemental pay functions, the associated number of purchased counts indicating the number of prepaid accesses to the given one of the plurality of supplemental pay functions.

However, Hellman discloses a system for distributing and managing access to a software program (see, for example, the abstract), including an associated number of purchased counts that indicates the number of prepaid accesses to the software program (see, for example, column 10, lines 8-13). The system enables the use of the software program to be authorized for a particular user terminal a specific number of times (see, for example, column 4, lines 37-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to include an associated number of purchased counts indicating the number of prepaid accesses to a given one of the plurality of supplemental pay

Art Unit: 2192

functions, so as to authorize the use of the supplemental pay function for a specific number of times, as taught by Hellman.

Reeder also discloses said database management means including fee charging means for charging a fee to add to the associated number of purchased counts for the given one of the plurality of supplemental pay functions (see, for example, page 9, lines 25-27, which shows fee charging means for charging a fee to access the supplemental pay functions, and page 13, lines 7-15, which shows that access to the functions may be prepaid).

Hellman likewise further discloses charging a fee to add to the associated number of purchased counts (see, for example, column 5, lines 51-56).

Reeder does not expressly disclose the software program being accessed for free unless access to the given one of the plurality of pay functions is requested.

However, Grundy discloses a system for distributing and managing access to a software program that is accessed for free unless access to certain functions is requested, so that the user may freely evaluate and legally distribute copies of the software program without paying a fee (see, for example, column 4, lines 28-42 and 51-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder such that the software program is accessed for free unless access to one of said plurality of pay functions is requested, as taught by Grundy, so as to allow the user to evaluate and legally distribute the software program without paying a fee.

Reeder also discloses:

(d) information communication means for connecting said database management means with said user terminal (see, for example, communications link 10 and network 20 in FIG. 1, and page 3, lines 21-31);

said software program providing system authorizing said user terminal to access the software program stored in said storage medium based on the information regarding the range of access limitations (see, for example, page 7, lines 30-37) and the information searched using the individual identification code as the search key (see, for example, page 6, line 37 to page 7, line 5), said database management means reading the individual identification code from said storage medium installed in said user terminal through said information communication means (see, for example, page 10, lines 6-17, which shows reading a identification code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions).

Hellman further discloses authorizing the user terminal to access the software program based on the associated number of purchased counts exceeding the associated number of used counts (see, for example, column 10, lines 33-54, which shows authorizing access to the software program if the associated number of purchased counts is greater than 0, i.e. if the associated number of purchased counts exceeds the number of times the software program was used).

Grundy further discloses:

said user terminal including a display having a graphical-unit-interface for enabling a user to select between free access to the software program and paid access to the software program including a selected one of the plurality of supplemental pay functions (see, for example, column 12, lines 6-24, which shows a graphical user interface on which the software

program displays a banner page to enable the user to select between free access to the software program in evaluation mode and paid access to the software program in full-function mode).

Reeder does not expressly disclose that said storage medium is a removable storage medium.

However, Oshima discloses a system for providing and managing access to a software program stored with an identification code on a removable, optical storage medium, wherein the software is installed on a user terminal from the removable storage medium, for the purpose of preventing illegal copying of the software (see, for example, column 10, lines 15-54, and see, for example, FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 3 (previously presented), the rejection of claim 1 is incorporated, and Reeder also discloses the limitation wherein said information communication means further comprises ciphering means for ciphering communication between said database and said user terminal (see, for example, page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 4 (currently amended), the rejection of claim 1 is incorporated. Reeder discloses the use of encryption to provide additional security (see, for example, page 5, line 33 to page 6, line 1), but does not expressly disclose that said storage means further



comprises a DVD-ROM, and the individual identification code includes a BCA code recorded using a laser beam during a fabrication process of the individual identification code.

However, Oshima further discloses the use of the BCA to store an identification code and a cryptographic key (see, for example, column 1, lines 36-50) on a DVD (see, for example, column 3, lines 63-67), so that a fee may be charged for the use of the disk (see, for example, column 4, lines 60-64). Oshima further discloses that the BCA code is recorded with a laser during fabrication and can be used for security (see, for example, column 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to use a DVD-ROM storage medium with a BCA identification code, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to improve security by transcribing the storage medium with an individual identification code.

With respect to claim 10 (currently amended), the claim recites a software program providing system that corresponds to the software program providing system of claim 1 (see the rejection of claim 1 above).

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MY

Michael J. Yigdall  
Examiner  
Art Unit 2192

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